



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/528,363	03/17/2000	Mason Ng	40827.00039	4258

30256 7590 10/27/2003

SQUIRE, SANDERS & DEMPSEY L.L.P
600 HANSEN WAY
PALO ALTO, CA 94304-1043

EXAMINER

LIN, KENNY S

ART UNIT	PAPER NUMBER
----------	--------------

2154

DATE MAILED: 10/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/528,363

Applicant(s)

NG ET AL.

Examiner

Kenny Lin

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. Claims 1-8 are presented for examination.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 3-6 are rejected under 35 U.S.C. 102(e) as being anticipated by Narasimhan et al (hereinafter Narasimhan), US Patent 6,073,165.

5. As per claims 3-4, Narasimhan taught the claimed invention including a method, comprising:

Art Unit: 2154

- a. Establishing a communication channel with a client computer system (col.1, lines 40-43, col.2, lines 50-65);
 - b. Receiving information corresponding to new email events from the client computer system (col.4, lines 6-11, col.6, lines 11-21, 40-56); and
 - c. Storing the information corresponding to the new email events in a database (col.4, lines 6-11, col.6, lines 11-21, 40-56).
6. As per claims 5-6, Narasimhan taught the claimed invention including a method comprising:
 - a. Obtaining filter control data (col.1, lines 46-49, col.2, lines 3-6);
 - b. Examining email data against the filter control data (col.5, lines 3-17);
 - c. Determining at least one transfer protocol for the email data based on the examination (col.5, lines 42-49, col.6, lines 40-56, col.7, lines 39-45); and
 - d. Forwarding the email data according to the at least one transfer protocol via a computer network to a database (col.6, lines 19-21, 40-56).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2154

8. Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al (hereinafter Chen), US Patent 6,510,455, in view of Paarsmarkt et al (hereinafter Paarsmarkt), US Patent 6,118,856, and Narasimham et al (hereinafter Narasimhan), US 6,073,165.

9. As per claims 1-2, Chen taught the invention substantially as claimed including a method, comprising:

- a. examining start criteria (col.6, lines 12-22);
- b. determining whether the start criteria have been met (col.6, lines 12-22, 25-31);
and
- c. obtaining new email events from an email database after the start criteria have been met (col.6, lines 25-52).

10. Chen did not specifically teach the method to forward information corresponding to the new email events via a computer network to a database. However, Paarsmarkt taught an email system to forward information or portion of information corresponding to the new email events via a computer network (col.2, lines 1-4, 15-17, 25-29, 48-52). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Chen and Paarsmarkt because Paarsmarkt's teaching of forwarding information or portion of information enables users to specify condition for forwarding received email to a remote device in Chen's email system. Chen and Paarsmarkt did not specifically teach that to forward information to a database. Narasimhan taught to store the information into database (col.4, lines 6-11, col.6, lines 11-21, 40-56). It would have been obvious to one of ordinary skill in the art at

Art Unit: 2154

the time the invention was made to combine the teachings of Chen, Paarsmarkt and Narasimhan because Narasimhan's teaching of storing the forwarded information in a database enables subsequent recall of information from the database (col.6, lines 11-21).

11. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Narasimhan et al (hereinafter Narasimhan), US Patent 6,073,165, in view of Moon et al (hereinafter Moon), US Patent 6,138,146.

12. As per claims 7-8, Narasimhan taught the invention substantially as claimed including a method, comprising:

- a. Obtaining filter control data (col.1, lines 46-49, col.2, lines 3-6);
- b. Examining email data against the filter control data (col.5, lines 3-17); and
- c. Determining based on the examination the email data that should not be forwarded (col.2, lines 3-6, col.5, lines 3-23);
- d. Generating receipt data identifying the email data that should be forwarded (col.1, lines 46-51, col.4, lines 6-11, col.6, lines 11-18); and
- e. Forwarding the receipt data via a computer network to a database (col.4, lines 6-11, col.6, lines 11-21, 40-56).

13. Narasimhan did not specifically teach the step of generating receipt data identifying the email data that should not be forwarded. Instead, Narasimhan taught to generate receipt data identifying the email data that should be forwarded (col.1, lines 46-51, col.4, lines 6-11, col.6,

Art Unit: 2154

lines 11-18) and forward the receipt data via a computer network to a database (col.6, lines 19-21, 40-56). However, it would have been obvious that by identifying the email data that should be forwarded is equivalent to identify the email data that should not be forwarded. Moon taught to identify the email data that should not be forwarded and send the email data that should not be forwarded back to the server (col.2, lines 30-40, col.6, lines 16-20, col.7, lines 22-30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Narasimhan and Moon because Moon's teaching of identifying the email data that should not be forwarded enables Narasimhan's email system to be aware of which email messages to filter or block.

Conclusion

14. Applicant's arguments with respect to claim 1-4 have been considered but are moot in view of the new ground(s) of rejection.

15. Applicant's arguments filed on 7/31/2003 with respect to claims 5-8 have been fully considered but they are not persuasive.

16. In the remark, applicant argued that: (1) As per claims 5-6, Narasimhan did not disclose determining transfer protocols for the email data based on the examination but teaches only a single message format and a single communication mechanism. (2) As per claim 7-8, Narasimhan did not teach to forward any sort of receipt data to a database.

Art Unit: 2154

17. Examiner respectfully traverse the argument that:

As to point (1), Narasimhan taught to use different protocols for data transfer (col.3, lines 10-20, 39-44) and suggested that many different communication protocols may be used (col.7, lines 42-45). In addition Narasimhan taught that the data transferring method can be determined (col.4, lines 42-47).

As to point (2), Narasimhan taught to send notice of receipt (col.3, lines 10-15, col.4, lines 6-11) to a database (col.6, lines 11-18).

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Nada et al, US 6,094,477.

Wells et al, US 6,125,281.

19. A shortened statutory period for reply to this Office action is set to expire THREE MONTHS from the mailing date of this action.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenny Lin whose telephone number is (703)305-0438. The examiner can normally be reached on 8 AM to 5 PM Tuesday to Friday and every other Monday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An can be reached on (703)305-9678. Additionally, the fax numbers for Group 2100 are as follows:

Official Responses: (703) 872-9306

Application/Control Number: 09/528,363


Page 8

Art Unit: 2154

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-6121.

ksl

October 6, 2003


ZARNI MAUNG
PRIMARY EXAMINER